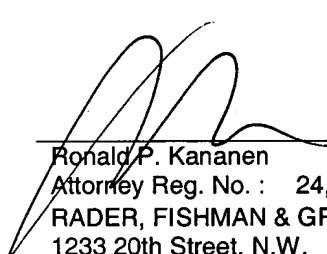


TRANSMITTAL OF APPEAL BRIEF			Docket No. SON-2552/KOI
In re Application of: Nishi Noriaki et al.			
Application No. 09/914,350	Filing Date August 27, 2001	Examiner G. Patel	Group Art Unit 2655
Invention: Optical Pickup Device That Corrects The Spot Shape Of Reflected Light Beams (As Amended)			
<p style="text-align: center;"><b><u>TO THE COMMISSIONER OF PATENTS:</u></b></p> <p>Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>November 29, 2004</u> .</p> <p>The fee for filing this Appeal Brief is <u>\$ 500.00</u> .</p> <p><input checked="" type="checkbox"/> Large Entity      <input type="checkbox"/> Small Entity</p> <p><input type="checkbox"/> A petition for extension of time is also enclosed.</p> <p>The fee for the extension of time is _____ .</p> <p><input type="checkbox"/> A check in the amount of _____ is enclosed.</p> <p><input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>18-0013</u> . This sheet is submitted in duplicate.</p> <div style="display: flex; justify-content: space-between; align-items: flex-end;"><div style="width: 60%;"> _____ Ronald P. Kananen Attorney Reg. No. : 24,104 RADER, FISHMAN &amp; GRAUER PLLC 1233 20th Street, N.W. Suite 501 Washington, DC 20036 (202) 955-3750</div><div style="width: 35%; text-align: right;"><p>Dated: <u>January 31, 2005</u></p></div></div>			
DC181950			



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<b>Effective on 12/08/2004.</b> <i>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</i> <b>FEE TRANSMITTAL</b> <b>For FY 2005</b>		<b>Complete if Known</b>	
		Application Number	09/914,350
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	August 27, 2001
		First Named Inventor	Nishi Noriaki
		Examiner Name	G. Patel
		Art Unit	2655
<b>TOTAL AMOUNT OF PAYMENT</b>		Attorney Docket No.	SON-2552/KOI

<b>METHOD OF PAYMENT</b> (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: <u>18-0013</u>
Deposit Account Name: <u>Rader, Fishman &amp; Grauer PLLC</u>	
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input type="checkbox"/> Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

<b>FEE CALCULATION</b>							
<b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>							
	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		
		<u>Small Entity</u>		<u>Small Entity</u>		<u>Small Entity</u>	
<u>Application Type</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>	<u>Fee (\$)</u>	<u>Fees Paid (\$)</u>
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____
<b>2. EXCESS CLAIM FEES</b>							
						<u>Small Entity</u>	
<u>Fee Description</u>						<u>Fee (\$)</u>	<u>Fee (\$)</u>
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
<u>Total Claims</u>		<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>		
_____		_____	x _____	= _____	<u>Fee (\$)</u>		<u>Fee Paid (\$)</u>
_____		_____	x _____	= _____	_____		_____
<b>3. APPLICATION SIZE FEE</b>							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>			
_____	_____	_____	_____	_____			
_____ - 100 = _____ / 50 _____ (round up to a whole number) x _____ = _____							
<b>4. OTHER FEE(S)</b>							
Non-English Specification - \$130 fee (no small entity discount)							
Other (e.g., late filing surcharge): <u>1402 Filing a brief in support of an appeal</u>						<u>500.00</u>	

<b>SUBMITTED BY</b>			
Signature	Registration No. (Attorney/Agent)	Telephone	
	24,104	(202) 955-3750	
Name (Print/Type)	Date		
Ronald P. Kananen	January 31, 2005		



Docket No.: SON-2552/KOI  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Nishi Noriaki et al.

Application No.: 09/914,350

Confirmation No.: 3695

Filed: August 27, 2001

Art Unit: 2655

For: Optical Pickup Device That Corrects The Spot  
Shape Of Reflected Light Beams (As Amended)

Examiner: G. Patel

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on November 29, 2004, and is in furtherance of said Notice of Appeal the period for response being extended because January 29, 2004 was a Saturday.

The fees required under § 41.20(b)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R.

§ 41.37 and M.P.E.P. § 1206:

02/01/2005 SDENB0B1 00000114 180013 09914350

01 FC:1402

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- |       |   |
|-------|---|
| I.    | Real Party In Interest                        |
| II.   | Related Appeals and Interferences             |
| III.  | Status of Claims                              |
| IV.   | Status of Amendments                          |
| V.    | Summary of Claimed Subject Matter             |
| VI.   | Grounds of Rejection to be Reviewed on Appeal |
| VII.  | Argument                                      |
| VIII. | Claims  |

IX.	Evidence
X.	Related Proceedings
Appendix A	Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Sony Corporation of Tokyo, Japan ("Sony"). An assignment of all rights in the present application to Nishi was executed by the inventor and recorded by the U.S. Patent and Trademark Office on **reel 012436 at frame 0584**.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 12 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 3, 6-8, 10, 11, 16, 19, 20, and 22-52
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1, 2, 5, 9, 12-15, 18, and 21
4. Claims allowed: none
5. Claims rejected: 1, 2, 5, 9, 12-15, 18, and 21

C. Claims On Appeal

The claims on appeal are claims 1, 2, 5, 9, 12-15, 18, and 21

#### IV. STATUS OF AMENDMENTS

Appellant filed an Amendment under 37 C.F.R. 1.111 on June 23, 2004, in response to non-final Office Action dated March 31, 2004 (Paper No. 12). The Examiner responded by issuing a final Office Action dated September 27, 2004. Appellant has filed concurrently herewith an Amendment After-Final Rejection that cancels non-elected claims 4 and 17 to place the application in better form for appeal.

The enclosed claims (see Appendix A) incorporate the amendments presented in the Amendment After-Final Rejection under 37 C.F.R. 1.111 filed concurrently herewith by Appellant. In particular, the claims on appeal incorporate the all amendments made in claims 1 and 14.

#### V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 recites an optical head 1104 comprising an objective lens 26 supported for movement; a light source 22 for radiating a light beam; light separating means 25, for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium 1102 from each other (page 15, lines 4-10; page 16 lines 2-6); light detecting means 10 for receiving said reflected light beam from said optical recording medium 1102 separated by said light separating means 25 (page 16, lines 11-16); and spot shape correction means 8 arranged between said objective lens 26 and said light detecting means 10; said spot shape correction means 8 correcting part or all of spots formed by said reflected light beam on said light detecting means 10 so that the spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track (page 16, lines 6-10), wherein said spot shape correction means includes a cylindrical lens 73 (page 22, lines 14-19). See also Figs. 2, 3A, 3B, 6A, and 6B.

Independent claim 14 recites a light receiving and emitting device comprising a light source 22 for radiating a light beam; light separating means 25 for separating the light beam radiated from said light source 22 and a reflected light beam from an optical recording medium 1102 from each other (page 15, lines 4-10; page 16 lines 2-6); light detecting means 10 for receiving said reflected light beam from said optical recording medium 1102 separated by said light separating means 25 (page 16, lines 11-16); and spot shape correction means 8 arranged between said light separating means 25 and said light detecting means 10; said spot shape

correction means 8 correcting part or all of spots formed by said reflected light beam on said light detecting means 10 so that a spot diameter in a direction of traversing a track on said optical recording medium 1102 will be larger than the spot diameter in a direction along said track (page 16, lines 6-10), wherein said spot shape correction means includes a cylindrical lens 73 (page 22, lines 14-19). See also Figs. 2, 3A, 3B, 6A, and 6B.

#### VI. GROUNDS OF OBJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 5, 9, 12-15, 18, and 21 were rejected under 35 U.S.C. §102 as anticipated by *Oinoue et al.*, U.S. Patent No. 6,044,048.

#### VII. ARGUMENT

Claims 1-3, 5, 9, 12-16, 18, and 21 were rejected under 35 U.S.C. §102(b) as anticipated by *Oinoue et al.*, U.S. Patent No. 6,044,048. Appellant respectfully traverses this rejection.

As a preliminary matter, the instant application is a national stage application under 35 U.S.C. §371 of PCT/JP00/09327 filed on December 27, 2000. *Oinoue* has an issue date of March 28, 2000. Consequently, *Oinoue* is not a reference under §102(b) as alleged in the Office Action. Rather, at best, *Oinoue* is a reference under §102(a). Accordingly, Appellant respectfully submits that the rejection under 35 U.S.C. §102(b) is improper, and should be withdrawn. However, in an effort to expedite prosecution Appellant will respond to the Office Action as if the claims were rejected under §102(a).

Independent claim 1 recites an optical head comprising an objective lens supported for movement; a light source for radiating a light beam; light separating means for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium from each other; light detecting means for receiving said reflected light beam from said optical recording medium separated by said light separating means; and spot shape correction means arranged between said objective lens and said light detecting means; said spot shape correction means correcting part or all of spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track, wherein said spot shape correction means includes a cylindrical lens.

Independent claim 14 recites a light receiving and emitting device comprising a light source for radiating a light beam; light separating means for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium from each other; light detecting means for receiving said reflected light beam from said optical recording medium separated by said light separating means; and spot shape correction means arranged between said light separating means and said light detecting means; said spot shape correction means correcting part or all of spots formed by said reflected light beam on said light detecting means so that a spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track, wherein said spot shape correction means includes a cylindrical lens.

In summary, claim 1 recites an optical head and claim 14 recites a light receiving and emitting device. Both claims include a light source, a light separating means, a light detecting means, and shape correction means wherein the shape correcting means includes a cylindrical lens. The cylindrical lens has a refractive index that only corresponds to a one-dimensional direction.

*Oinoue* discloses an optical pickup and optical disc device that comprises a semiconductor laser element 21, a grating 22 as a light dividing means, a beam splitter 23 as light splitting means, a raising mirror 24, a collimator lens 25, an objective lens 26, a photodetector 27 and a biaxial actuator 30. *See* col. 4, line 65 through col. 5, line 3. *Oinoue* further discloses that the grating 22 may be replaced with a hologram element, provided that the light beam can be divided into at least three light beams. *See* col. 5, lines 9-17. *Oinoue* fails to disclose, teach, or suggest that said spot shape correction means includes a cylindrical lens as recited in claims 1 and 14.

The Office Action alleges that *Oinoue* teaches the cylindrical lens element at col. 6, lines 50-65 (cylindrical portion 101). The Office Action acknowledges that *Oinoue* does not explicitly show the cylindrical portion 101 in the figures, but alleges that based on its description the cylindrical portion 101 anticipates the cylindrical lens element recited in the claims. *Oinoue*, however, does not disclose, teach, or suggest that the cylindrical portion 101 is in fact a lens. In contrast, *Oinoue* teaches that cylindrical portion 101 is a structural portion of the lens holder 33, and particularly, the cylindrical portion 101 attaches the lens holder 33 to the shaft 32 or enables the lens holder 33 to be supported by shaft 32. *See* Fig. 8, elements 32, 34. Moreover, *Oinoue* teaches that the lens holder 33 moves in a lateral or focus direction to selectively introduce

objective lenses 26a, 26b into the optical path defined between the laser element 21 and the recording surface of the optical disc 11. Appellant adds that neither of the objective lenses 26a and 26b are described by *Oinoue* as having a cylindrical shape. For at least these reasons, the cylindrical portion 101 of *Oinoue* does not anticipate the cylindrical lens element recited in the claims.

The Office Action further alleges that the collimator lens 25 is “cylindrical by nature” and is held by the cylindrical portion 101 of the lens holder 33 (see page 5 at “SECOND” argument). In contrast, however, *Oinoue* does not teach that the collimator lens 25 is held by the cylindrical portion 101. In fact, *Oinoue* teaches that the collimator lens 25 “has its lateral edge towards the shaft 32...for avoiding possible conflict of the collimator lens 25 with a focusing coil 34, a focusing yoke 36, or a focusing magnet 37 (see Fig. 5; col. 5, lines 59-65). As discussed above, the cylindrical portion 101 attaches the lens holder 33 to the shaft 32 or enables the lens holder 33 to be supported by shaft 32. Therefore, the mere fact that the cylindrical portion 101 is cylindrical does not suggest or support the position that the collimator lens 25 is also cylindrical, especially when the cylindrical portion 101 does not house or support the collimator lens 25 in any fashion. Further, Appellant finds no support in *Oinoue* or otherwise that a collimator lens is “cylindrical by nature.” Absent supporting evidence, this statement is effectively a taking of Official Notice.

In a memo to the Examining Corps and Technology Center Directors, Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, stated that reliance on “Official Notice” when an application is under final rejection should be rare. See “Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice,” United States Patent and Trademark Office, memo from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, page 2 (February 2002). Moreover, Mr. Kunin stated, “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” See *Id.* “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” See *Id.*



In addition, if the Examiner believes that claims 1 and 14 still read on a prior art reference, Appellant hereby requests that the Examiner re-open prosecution and either:

- (a) Provide another non-final Office Action withdrawing the Official Notice, and applying a suitable reference for the asserted rejection;  
or
- (b) Issue another rejection under an appropriate statutory provision  
and  
provide an affidavit or suitable reference attesting to all the  
elements  
taken as Official Notice.

By this reply, Applicant has timely challenged the Examiner's Official Notice.

Further, the Office Action alleges that although the cylindrical portion is not described as a separate lens, the cylindrical portion is a structural part of the lens assembly and because the system of *Oinoue* produces an elliptical spot, this system must include a cylindrical shaped lens or portion (see page 6 at "THIRD" and "FOURTH" arguments; see also page 6 "FIRST" and "SECOND" arguments). This argument is mere speculation and is not substantiated by any of the applied art of record. For at least this reason, the Office Action appears to effectively take Official Notice on this issue. Accordingly, Appellant respectfully requests that the Examiner provide documentary evidence to support this position. By this reply, Appellant has timely challenged the Examiner's Official Notice.

Based on the arguments presented above, Appellant submits that *Oinoue* fails to anticipate every element recited in claims 1 and 14. In particular, *Oinoue* fails to disclose, teach, or suggest at least said spot shape correction means includes a cylindrical lens.

To properly anticipate a claim, the document must disclose, explicitly or implicitly, each and every feature recited in the claim. See Verdegall Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *Oinoue* fails to disclose, teach, or suggest every element recited in independent claims 1 and 14, therefore these claims are not anticipated by *Oinoue*. Accordingly, Appellant respectfully requests that the final rejection of claims 1 and 14 under 35 U.S.C. §102 be reversed.

Claims 2, 5, 9, 12, and 13 depend from claim 1, and claims 15, 18, and 21 depend from claim 14.. By virtue of this dependency, Appellant submits that claims 2, 5, 9, 12, 13, 15, 18, and 21 are allowable for at least the same reasons given above with regard to their respective base claims. In addition, Appellant submits that claims 2, 5, 9, 12, 13, 15, 18, and 21 are further

distinguished over *Oinoue* by the additional elements recited therein, and particularly with respect to each claimed combination. Appellant respectfully requests, therefore, that the rejection of claims 2, 5, 9, 12, 13, 15, 18, and 21 under 35 U.S.C. §103 be reversed.

#### VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Appellant on September 27, 2001.

#### IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

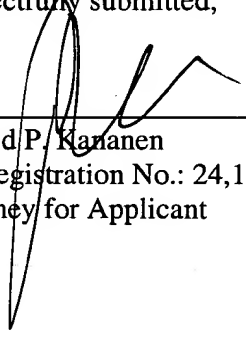
#### X. RELATED PROCEEDINGS

No related proceedings are referenced at item II above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Dated:

*Jan. 31, 2005*

Respectfully submitted,

By   
Ronald P. Karanen  
Registration No.: 24,104  
Attorney for Applicant

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**APPENDIX A**

**Claims Involved in the Appeal of Application Serial No. 09/914,350**

1. (PREVIOUSLY PRESENTED) An optical head comprising:  
an objective lens supported for movement;  
a light source for radiating a light beam;  
light separating means for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium from each other;  
light detecting means for receiving said reflected light beam from said optical recording medium separated by said light separating means; and  
spot shape correction means arranged between said objective lens and said light detecting means;  
said spot shape correction means correcting part or all of spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track, wherein said spot shape correction means includes a cylindrical lens.
2. (ORIGINAL) The optical head according to claim 1 wherein said spot shape correction means corrects part or all of said spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction along the track on the optical recording medium will be approximately minimum.
3. (CANCELED).
4. (CANCELED)
5. (ORIGINAL) The optical head according to claim 1 wherein said spot shape correction means includes a hologram device.
6. - 8. (CANCELED)

9. (ORIGINAL) The optical bead according to claim 1 wherein said light detecting means for receiving said reflected light beam includes at least one set of light receiving sections, obtained on splitting, and wherein at least one of tracking error signals, address signals and clock signals is obtained by a push-pull method using said light receiving sections.

10. (CANCELED).

11. (CANCELED).

12. (ORIGINAL) The optical head according to claim 1 wherein divergence angle converting means for converting an incident numerical aperture to light separating means to a smaller value is provided between said light source and said light separating means.

13. (ORIGINAL) The optical head according to claim 12 wherein said divergence angle converting means includes a coupling lens.

14. (PREVIOUSLY PRESENTED) A light receiving and emitting device comprising:

a light source for radiating a light beam;

light separating means for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium from each other;

light detecting means for receiving said reflected light beam from said optical recording medium separated by said light separating means; and

spot shape correction means arranged between said light separating means and said light detecting means;

said spot shape correction means correcting part or all of spots formed by said reflected light beam on said light detecting means so that a spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track, wherein said spot shape correction means includes a cylindrical lens.

15. (ORIGINAL) The light receiving and emitting device according to claim 14 wherein said spot shape correction means corrects part or all of said spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction along the track on the optical recording medium will be approximately minimum.

16. (CANCELED)
17. (CANCELED)
18. (ORIGINAL) The light receiving and emitting device according to claim 14 wherein said spot shape correction means includes a hologram device.
19. (CANCELED).
20. (CANCELED).
21. (ORIGINAL) The light receiving and emitting device according to claim 14 wherein said light detecting means for receiving said reflected light beam includes at least one set of light receiving sections, obtained on splitting, and wherein at least one of tracking error signals, address signals and clock signals is obtained by a push-pull method using said light receiving sections.
22. - 52. (CANCELED)